



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,237	12/08/1999	Michael R. Loeb	3203-4015	7462

7590 11/05/2002

MORGAN, LEWIS & BOCKIUS
COUNSELORS AT LAW
1701 MARKET STREET
PHILADELPHIA, PA 19103-2921

EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/457,237	LOEB ET AL.
	Examiner	Art Unit
	Tim Brown	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 July 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 31-34 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 31-34 and 42-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 December 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This Final Office Action is a reply to Applicants' response submitted July 31, 2002.
2. Claims 1-30 and 35-41 have been cancelled. Claims 31-34 and 42-45 are pending.

Drawings

3. The objections to the drawings have been withdrawn in response to the applicants' amendment.

Claim Objections

4. The Examiner withdraws the claim objections. These objections are moot because the objectionable claims have been cancelled.

Claim Rejections - 35 USC § 112

5. The Examiner withdraws the rejections made under 35 U.S.C §112. These rejections are moot because the rejected claims have been cancelled.

Response to Arguments

6. Applicant's arguments with respect to claims 31-34 and 42-45 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 31-33, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US 6,055,513) in view of Sixtus (US 5,903,721) and Official Notice.**

9. Regarding claim 31, Katz teaches a method of facilitating online transactions based upon interactions between customers and merchants comprising:

providing by a first merchant online to a customer an incentive for completing a sales transaction with the first merchant (col. 9, lines 6-11; col. 11, lines 22-32; col. 13, lines 20-25 and 52-67; col. 17, lines 60-65; col. 19, lines 16-32; col. 21, lines 3-9; and col. 22, lines 31-35);

displaying an offer to the customer, graphically on-line, the offer selected according to data associated with the identification of the customer and the customer's purchase history, the offer being displayed while the customer is still connected to the first merchant (col. 8, lines 34-45; col. 9, lines 6-21; col. 10, lines 46-55, 66 and 67; col. 11, lines 1-6; and 27-45; col. 14, lines 40-51; col. 18, lines 2-15 and 27-39; col. 19, lines 53-58; and col. 24, lines 12-30);

receiving online by the first merchant an acceptance of the offer from the customer (col. 8, lines 34-45; col. 9, lines 6-21; col. 11, lines 22-45; col. 17, lines 8-12; col. 18, lines 32-39; and col. 21, lines 2-9); and

processing by the first merchant, the acceptance using the customer payment information (Id.).

Katz does not precisely teach transmitting a reason code and a customer identifier from the first merchant to a *second merchant* indicating that the customer has

completed the sales transaction with the first merchant, the reason code including an electronic address for communicating with the customer and information relating to the customer and the incentive, and receiving the acceptance of the offer by *the second merchant*. However, completing a commercial transaction, by a second vendor, based on marketing data submitted by a first vendor is old and well known in the art.

At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Katz to include the well-known step of completing a commercial transaction, by a second vendor, based on marketing data submitted by a first vendor. This modification would have been obvious for several reasons. First, sending marketing data to the second vendor would enable the second vendor to present a targeted offer to the user while the user is in purchasing mood. Second, the user would be presented with an offer to purchase an item that is likely to be needed before the user has procured the item from an alternative source. Third, the first merchant would be provided with the ability to improve its good will by offering the customer a wider range of product options. Thus, the first merchant would be provided with the ability to procure items desired by the user despite the items being out of stock.¹ Fourth, Katz itself suggests combining its teachings with the well known step of sending marketing data to a second vendor. Katz discloses that the targeted offers it makes are based on marketing data obtained from third party vendors (col. 8, lines 64-67; col. 9, lines 1-5 and 22-27; and col. 10, lines 7-24). Katz further discloses that the vendor which receives the marketing data and submits targeted offers accordingly may

be a remotely-located third party (col. 16, lines 23-31; and col. 26, lines 51-65). In light of the foregoing, it would have been obvious to one of ordinary skill to modify Katz to include sending marketing data from the first vendor to the second vendor.

The examiner notes Katz does not teach sending the customer's payment information to the second vendor, from the first vendor, in response to a request from the second vendor. However, Sixtus teaches a payment clearinghouse wherein a transaction verification request is submitted from one vendor to another (see Abstract). The verification request includes a customer ID (Id.). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Katz to include the teachings of Sixtus in that sending the customer's payment information to the second vendor, from the first vendor, in response to a request from the second vendor would allow the customer to purchase items from different vendors without having to repeatedly input payment information.

Regarding claim 32, Katz and Sixtus teach all the limitations discussed under claim 31 above. Katz and Sixtus do not expressly teach decoding a data item to obtain the reason code and customer identifier. However, Sixtus does disclose the use of encryption technology to protect the privacy of the user (col. 14, lines 30-39). At the time of the applicants' invention, it would have been obvious to modify the encryption feature of Katz to include decoding a data item to obtain the reason code and customer identifier in order to prevent the unauthorized use/access of the customers information during transmission to the second merchant.

¹ Katz suggests achieving this benefit in that it discloses suggesting items to a user based upon the

Regarding claim 33, Katz and Sixtus teach all the limitations discussed under claim 31 above. Katz does not teach receiving by the second merchant SKU information from the first merchant and the second merchant assembling the offer based on the SKU information. However, Sixtus teaches assembling a transaction request message including identifying an item for purchase by SKU (col. 9, lines 22-32). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Katz to include the teachings of Sixtus in that identifying the customer's purchase history by SKU information would provide a specific and universal means for identifying items in the customer's purchase history profile.

Claim 42 is rejected under Katz in view of Sixtus as discussed under claim 31 above as claim 42 recites a system for accomplishing the method of claim 31.

Claim 43 is rejected under Katz in view of Sixtus as discussed under claim 32 above as claim 43 recites a system for accomplishing the method of claim 32.

Claim 44 is rejected under Katz in view of Sixtus as discussed under claim 33 above as claim 44 recites a system for accomplishing the method of claim 33.

10. Claims 34 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US 6,055,513) in view of Sixtus (US 5,903,721), Official Notice and Linden et al. (US 6,266,649).

Regarding claim 34, Katz and Sixtus teach all the limitations discussed under claim 33 above. Katz and Sixtus do not specifically teach receiving by the second merchant prioritization information from the first merchant for a compound purchase,

and the second merchant assembling offer components according to the prioritization information. However, Linden teaches recommending products to a consumer based on the consumer's purchase history profile wherein the recommendations are provided with a relevancy score (see Abstract). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Katz and Sixtus, to include the teachings of Linden. Providing prioritization information to the second merchant and having the second merchant assemble an offer based on the prioritization information would enable him to offer the customer that are most likely to be purchased.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Barber (US 6,298,318) Method and architecture for multi-level commissioned advertising on a computer network
- b. Merriman et al. (US 5,948,061) Method of delivery, targeting, and measuring advertising over networks
- c. Cockrill et al. (US 6,473,740) Electronic Commerce using a transaction network
- d. Scroggie et al. (US 6,014,634) System and method for providing shopping aids and incentives to customers through a computer network
- e. Arnold et al. (US 6,016,504) Method and system for tracking the purchase of a product and services over the Internet

f. Garndeswartz et al. (US 6,055,573) teaches transmitting a targeted advertisement to a consumer based on the consumer's purchase history with other vendors, the advertisement being directed to a unique customer address (Abstract; Figs. 2(a) and 5; col. 5, lines 5-13; and col. 10, lines 23-34).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers

Application/Control Number: 09/457,237
Art Unit: 3625

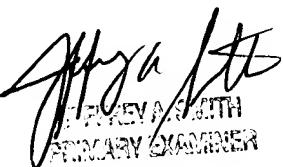
Page 9

for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown
Examiner
Reg. No. 48,069
Art Unit 3625

tb
November 1, 2002



JEFFREY A. SMITH
PRIMARY EXAMINER